

REMARKSCLAIM REJECTIONS

Claims 1-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miklos in view of Egger et al. In response, Applicant respectfully traverses these rejections.

There are many reasons which claim 1-20 are not obvious based upon Miklos in view of Egger et al., and there are many differences between each of the claims and the cited references. Applicant appreciates the Examiner Interview of October 7, 2004 and acknowledges receipt of the "Interview Summary" dated October 12, 2004, documenting the Examiner's agreement with Applicant's attorney that the pending claims are distinguishable over the prior art of record. Accordingly, Applicant respectfully requests that the rejections of claims 1-20 be withdrawn.

TRAVERSAL OF CLAIM REJECTIONSClaims 1-20 Should be Allowed Because of No Basis for Combining References

Applicant submits that the claim rejections under 35 U.S.C. 103(a) as being unpatentable over Miklos in view of Egger et al. are inappropriate on the independent basis that there is no suggestion or motivation provided in Miklos and/or Egger et al. to make the combinations proposed by the Examiner. Obviousness is not established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion that the combination be made. In re Stencel, 828 F.2d 751, 4 U.S.P.Q.2d 1071 (Fed. Cir. 1987); In re Geiger, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir.

FROM : E RANDALL SMITH

FAX NO. : 7135283629

Feb. 02 2005 01:04PM P11

APP. SERIAL NO.: 10/002,793

1987); In re Niclson, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987); In re Keller, 642 F.2d 413 (Fed. Cir. 1981).

In this regard, Applicant notes that the Examiner has provided no objective evidence of a suggestion, teaching or motivation to combine the cited references, as required by controlling law. Specifically, the Examiner has not provided appropriate explanation as to where the Examiner finds support for *combining* Miklos and Egger et al. in relation to each claimed combination. Indeed, Applicant submits that no such support exists. As stated by the Court of Appeals for the Federal Circuit in In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 12430, 1433 (Fed. Cir. 2002):

“The factual inquiry whether to combine references must be thorough and searching.” It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. The need for specificity pervades this authority.

(citations omitted.) According to the Federal Circuit in In re Lee, the factual question of motivation to combine for purposes of the obviousness inquiry is material to patentability, and can neither be resolved on subjective belief and unknown authority, nor stand if supported only by conclusory statements.

Further, obviousness is not determined by the application of hindsight, or retrospect, with the knowledge of the Applicant's discovery. Id.; See also, Schnell v. Allbright-Nell Co., 348 F.2d 444, 447 (7th Cir. 1965); In re Nomiya et al., 509 F.2d 566 (CCPA 1975); In re Leonor, 395 F.2d 801 (CCPA 1968). As articulated by the Federal Circuit in In Re Rouffet, 47 U.S.P.Q.2d 1450 (Fed. Cir. 1998), “the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal

APP. SERIAL NO.: 10/002,793

test for obviousness." Id. at 1458. Applicant submits that the Examiner's selection and combination of references applied in this case is solely with the assistance of hindsight.

The Office has the burden to go forward and cite a factual basis for its legal conclusions. Ex parte Parthasarathy and Ciapetta, 174 U.S.P.Q. 63 (Bd.App. 1971); In re Rinchart, 531 F.2d 1040, 189 U.S.P.Q. 143, 147 (CCPA 1976); In re Carleton, 599 F.2d 1021, 202 U.S.P.Q. 165, 168 (CCPA 1979). See In re Garrett, 33 BNA PTCJ 43 (1986), where the Board of Patent Appeals and Interferences criticized the Examiner's statement that the proposed modification therein under scrutiny would have been "an obvious matter of venturing design choice." In the present case, there is no objective suggestion or motivation to combine Miklos and Egger, and this rejection cannot stand. As such, the obviousness rejections of claims 1-20 based on the cited combinations are inappropriate. Applicant submits that all claims are therefore in condition for allowance.

Independent Claims 1, 3, 18, 19 and 20 are Patentable

There are many differences between independent claims 1, 3, 18-20 and the cited references. For example, as discussed with, and agreed by, the Examiner in the Interview occurring on October 7, 2004, Miklos does not teach claim 1's requirement "wherein the displayed search results appear within their respective parent categories." In Miklos, as shown in Figure 6, only "child" files – *not* search results - are shown in the context of the "parent windows." Miklos does not show any search results within their respective parent categories.

The same rationale applies to claims 3, 18 and 19, which each require graphically displaying search results *within* at least one category icon, and claim 20's requirement of

FROM : E RANDALL SMITH

FAX NO. : 7135283629

Feb. 02 2005 01:05PM P13

APP. SERIAL NO.: 10/002,793

"displaying matching search results in the context of their respective parent categories".

On this basis alone, the rejection of claims 1-20 should be withdrawn and these claims allowed.

AMENDMENTS TO CLAIMS

In this paper, various amendments have been made to certain claims. All such claim amendments are voluntary amendments by the Applicant. These amendments were made for business reasons, including a strategic business decision to focus the amended claims more specifically on particular commercial embodiments of the invention.

The amendments were not required by the Examiner and were not made in response to a rejection by the Examiner, to distinguish the invention from any prior art or for any reason related to the statutory requirements for a patent (e.g. novelty, non-obviousness, patentable subject matter, utility or any requirements of 35 U.S.C. Section 112). Applicant submits that the pre-amendment claims met all the statutory requirements for a patent. Supporting this fact are the arguments/example reasons for patentability provided above based upon the previous claim language.

CONCLUSION

In summary, the Examiner rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Miklos in view of Egger et al. In light of the foregoing remarks, Applicants submit that all pending claims (claims 1-20) are now allowable, and an early notice to that effect is earnestly solicited. Should a telephone interview help speed up

FROM : 'E RANDALL SMITH

FAX NO. : 7135283629

Feb. 02 2005 01:05PM P14

APP. SERIAL NO.: 10/002,793

resolution of this application, or if the Examiner has any questions or comments regarding this communication, a call would be greatly appreciated.

In the Remarks above, Applicant has at various times referred to particular aspects of patents cited by the Examiner or certain aspects or language of the pending claims, or to one or more distinctions between such patents and claims. It is not intended by mentioning any such aspects and distinctions to create any implied limitations in the referenced claims or any other pending claims. Such remarks are intended strictly to educate the Examiner and are not intended to create estoppel. Furthermore, the Remarks above are not to be considered to be exhaustive of the facets of the referenced pending claims that render such claims patentable, but only examples of features which Applicants' Attorney chooses to mention at this time. In construing a claim of this patent, evaluating a prior art reference or making any comparison of a pending claim to a prior art reference, the claim should be construed in its entirety and compared to the reference as a whole.

With respect to the pending claims, it should be noted that it is Applicants' intent not to invoke 35 U.S.C. § 112, ¶ 6 for any of the elements of any of pending claims. Also, it should be understood generally that none of the pending claims are intended to be limited to being performed in any particular order or with any particular apparatus.

If any fees are inadvertently omitted or if any additional fees are required, please appropriately charge those fees to E. Randall Smith, P.C. Deposit Account Number 501294.

FROM : 'E RANDALL SMITH

FAX NO. : 7135283629

Feb. 02 2005 01:06PM P15

APP. SERIAL NO.: 10/002,793

Respectfully submitted,

E. RANDALL SMITH
Reg. No. 38,307
2777 Allen Parkway, Suite 1000
Houston, Texas 77019
(713) 528-3100
Fax: (713) 528-3629
ATTORNEY FOR APPLICANT